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PATENT
Attorney Docket No.: 08321-0197US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Patent application of Carlo M. Croce, et al.	:	
		:	Group Art Unit:
Serial No.	09/855,294	:	1647
Filed:	May 15, 2001	:	Examiner: Robert Clinton Hayes
For:	CRYSTAL STRUCTURE OF WORM NITFHIT REVEALS THAT A NIT TETRAMER BINDS TWO FHIT DIMMERS	:	Conf. No. 1905

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is in further response to the Office Action mailed January 13, 2004, and in response to the Advisory Action mailed July 14, 2004. A Request for Continued Examination was filed July 13, 2004. Claim 2 stands rejected as allegedly anticipated by WO 01/94566 of Lexicon Genetics, Inc.

Examiner *acknowledges* that WO 01/94566 does not formally *list* the United States as a designated state. However, Examiner maintains that the document is a reference against the present application under 35 U.S.C. 102(e)(1), because of the claim of priority to U.S. provisional application 60/179,000, filed January 28, 2000. Examiner apparently maintains that when a PCT application claims priority to a U.S. provisional application, "the U.S. is

CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8(a)

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

BY Susan Pasuk Susan Pasuk

DATE: July 21, 2004

thereby designated". Applicants respectfully submit that Examiner is incorrect as a matter of law.

Examiner refers in the Advisory Action to "training materials" which allegedly support his position. The only relevant training materials known to the undersigned are the "Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendment Act of 2002 and 35 U.S.C. § 102(g)(revised)" (hereinafter "Guidelines"). Examiner is requested to identify any other "training materials" which are believed to support his position.

As indicated in the Guidelines, 35 U.S.C. 102(e)(1) created a class of prior art documents constituting publications of patent applications. An international application filed after November 29, 2000, constitutes the United States filing date for prior art purposes if the international application **designated the United States** and was published under Patent Cooperation Treaty Article 21(2) in the English language. The relevant language of 35 U.S.C. 102(e)(1) is as follows:

> an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application ***designated the United States*** and was published under Article 21(2) of such treaty in the English language[.]

The requirement for a U.S. designation and publication in English is emphasized at page 3 of the guidelines:

> **E. Additional requirements for international application filed on or after November 29, 2000.**
> If an international application was filed on or after November 29, 2000, the international application must have **designated the U.S.** and been **published in English** under PCT Article 21(2) by WIPO in order for its international filing date to be a U.S. filing date for purposes of § 102(e) and be relied upon as a prior art date.

Notably, the Guidelines also address the situation at hand, namely an international application containing an earlier filing date to a priority or benefit claim:

> **F. When an international application cannot serve as a bridge to an earlier-filed application.**
> International applications, which: (1) were filed prior to November 29, 2000, (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier

> filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. § 102(e).

According to the Guidelines, the failure of WO 01/94566 to *designate the United States* disables that document from ever becoming a reference against a U.S. patent application under 35 U.S.C. 102(e)(1). The priority claim of WO 01/94566 back to U.S. provisional application 60/179,000 is of no consequence in avoiding this clear mandate.

Examiner's attention is further directed to the Guidelines, Section IV, entitled "Examination Procedures under 35 U.S.C. §§ 102(e) and 374. The following examination procedure is mandated at page 7, part (4)(c)(ii):

> If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for use under 35 U.S.C. § 102(e) as a prior art date. In this situation, do **not** apply the reference as of its international filing date...*or any earlier filing date to which such an international application claims benefit of priority.*

Again, the Guidelines are clear that a priority claim in a post November 29, 2000 filed international application which does not designate the United States is irrelevant and does not save the document from exclusion as a reference under Section 102(e)(1).

The priority claim of WO 01/94566 to U.S. provisional application 60/179,000 does not serve as a designation of the United States within the meaning of the Patent Cooperation Treaty. According to Article 4 of the Treaty, a "designated State" is a contracting state of the Patent Cooperation Treaty in which protection for an invention is desired on the basis of an international application. Such designations are made in a PCT "Request" filed with the international application. PCT Article 4 thus provides:

> (1) The request shall contain:
>
> (i) a petition to the effect that the international application be processed according to this Treaty;
>
> (ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States")...

The states in which a PCT applicant wishes to protect an invention, (*i.e.*, the "designated States"), are listed by in the Request. This list of countries is collected from the Request and published in the international application under two fields: "(81) Designated States (national)" and "(84) Designated States (regional)." If a country is not listed in either

of these fields on the face of a published PCT application, *it is not a "Designated state" under the international application in question.*

There is no provision of the Patent Cooperation Treaty which recognizes that the country of a priority application automatically becomes a designated State. The term "designated State" has a fixed meaning under the Patent Cooperation Treaty, and has the same meaning under Section 102(e). A "designated State" is a country listed under fields (81) or (84) on the face of a PCT publication, and nothing more. The United States is not a designated State under WO 01/94566.

For the reasons stated in the Response Under 37 C.F.R. 1.116 filed June 1, 2004, and for the further reasons stated in the herein Response, WO 01/94566 is not a competent reference against the present application under 35 U.S.C. 102(e)(1). The only effective date of WO 01/94566 as a reference is its international publication date of December 13, 2001, which post-dates applicant's filing date. Cleary, WO 01/94566 is not prior art against the present application.

Reconsideration and withdrawal of the 35 U.S.C. 102(e)(1) rejection of claim 2 as allegedly anticipated by WO 01/94566 is again respectfully requested.

Respectfully submitted,

CARLO M. CROCE, ET AL.

BY

DANIEL A. MONACO
Reg. No. 30,480
DRINKER BIDDLE & REATH LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996
Tel.: (215) 988-3312
Fax: (215) 988-2757
Attorney for the Applicants